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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/581,560 07/17/00 BRUCHMANN

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EXAMINER

022850 IM52/0305
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ART UNIT

PAPER NUMBER

1711
DATE MAILED:

03/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/581,560

Applicant(s)

Bruchmann et al.

Examiner

Rabon Sergent

Group Art Unit

1711



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. The instant application has been filed with two sets of claims. The first set contains 11 claims; the second set contains 9 claims and each page of the second set is denoted as being an amended sheet. The second set has been examined in view of the remarks within the preliminary amendment and the application transmittal letter.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is unclear with respect to exactly what components are required to be present within the mixture. It is unclear if both Ia and Ib are required to be present. Furthermore, it is presumed that structures IV and V are required to be present. Clarification is required.

Secondly, the definition of R^1 and R^2 is confusing. Within the first line of the definition, there appears to be a word omission after "radicals". Furthermore, it is unclear if applicants are stating that R^1 and R^2 have different definitions within lines 21-30. Also, there is no indication that R^1 and R^2 can both be radical III.

Thirdly, the use of "may" throughout the claims renders them indefinite, since it is unclear if or to what extent the language denoted by "may" is optional.

Fourthly, the second definition of R^3 is confusing, because it is not clear that the pyrrolidone radical or morpholine radical attaches to the C_1 - C_4 -alkyl radical. Also, it is unclear if combinations of the R^3 definition may be present within the mixture.

Art Unit: 1711

Fifthly, the reference to claim 1 within line 10 of page 15 is confusing, because the claim is claim 1.

Sixthly, it is unclear if the isocyanurates may be derived from mixtures of the two diisocyanates.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have failed to provide a basis for the claimed weight percent.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have referred to diisocyanate (Ic); however, this diisocyanate is not specified in claim 1.

5. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is unclear if mixtures of the alcohols are encompassed. Also, it remains unclear that the pyrrolidone or morpholine radical attaches to the C₁-C₄-alkyl group of the alcohol.

Secondly, within step i, if only isophorone diisocyanate is used, then it appears that claim 1 does not provide for such a diisocyanate product containing only the isophorone radical. If

Art Unit: 1711

only hexamethylene diisocyanate is used, then diisocyanate (Ib) could not result. If mixtures of the diisocyanates are used, then diisocyanate (Ia) could not result.

6. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have not provided adequate description with respect to the ISO 3219, Annex B standard.

7. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the ISO 3219, Annex B standard has not been clearly described, the claimed viscosities and the means of determining them have not been enabled.

8. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reference to (I) is not understood. Is only diisocyanate (I) intended to be present as component B?

Art Unit: 1711

9. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "sheetlike manner", renders the claims indefinite, because it is unclear what is meant by the language. Furthermore, the use of the suffix, "-like", so extends the scope of the word that it is rendered indefinite.

10. The disclosure is objected to because of the following informalities: The reference to "claim 1" within line 42 of page 5 is improper and insufficient to define R³.

Appropriate correction is required.

11. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In view of the issue raised within paragraph 5, regarding the various diisocyanate starting materials, the position is taken that applicants have not provided adequate description with respect to exactly what components are present within the mixture, depending on the starting reactants. Furthermore, diisocyanate (Ic) has not been defined.

12. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 1711

Applicants have failed to provide adequate enablement for using the various diisocyanate starting reactants to yield the specified mixture, having all of the claimed species. Again, applicants' attention is directed to paragraph 5 of this Office action.

13. Given the severity of the 35 USC 112 issues, the position is taken that a meaningful and productive prior art search and prior art analysis of the claims is not possible with respect to the claims, as drafted.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent/om
February 10, 2001